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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,896	06/21/2001	Ignacio Larrain	112843-25	2983
29157	7590	12/16/2004	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			DESANTO, MATTHEW F	
			ART UNIT	PAPER NUMBER
			3763	

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/681,896	Applicant(s) LARRAIN ET AL. <i>CL</i>	
	Examiner Matthew F DeSanto	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7,8 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,8 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1 – 2, 7, 19 and 20 rejected under 35 U.S.C. 102(b) as being anticipated by Brignola (USPN 4,244,378).

Brignola discloses a valve system with an inlet, and outlet, a flexible membrane, which deforms under pressure, and has a perforation for fluid to pass through, and has a cracking pressure approximately .10 bar to .20 bar, and wherein the valve includes a piston having a mushroom shaped head (90) and stem (92), (Figures 4, 5, 8, 9, 18, and entire reference).

2. Claims 1, 2, 7, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Werge et al. (USPN 5,535,785).

Werge et al. discloses a valve system with an inlet, and outlet, a flexible membrane, which deforms under pressure, and has a cracking pressure of .10 bar to .20 bar. and wherein the valve includes a piston having a mushroom shaped head. (Figure 1, 1A, 1B, 3, 4 and entire reference)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 7, 8 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werge et al. applied to the claims above, and further in view of Cordner, Jr. et al. (5244463) and Minshall et al. (5009654).

Werge et al. disclosed the claimed invention with a pump and a fluid being administered to a patient but failed to disclose the specific pump used and the specific fluid that will be passed through the valve.

Since Werge et al. disclosed that any pump and any fluid can be used in accordance with the valve, it would have been obvious to combine the references since it is well known in the art to use a rotary peristaltic pump with a check valve such as shown with Minshall et al. (Column 5, line 13-26) and using a pump with a check valve when delivering nutrition to a patient, such as shown with Cordner, Jr. et al. (Column 1, lines 54-64, and entire reference).

Therefore it would have been obvious to combine Werge et al. with Cordner, Jr. et al. and Minshall et al. to obtain the invention as specified in claims 1, 2, 7, 8, and 14-20.

Response to Arguments

5. Applicant's arguments filed 10/21/04 have been fully considered but are not persuasive.

6. The examiner has considered the prior art and the prior art still reads on the claims of the present application because the claims read "a piston member with a

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single stem" which means the prior art needs to have at least one single stem. The prior art can have more than a single stem because the claim does not say only one stem. The examiner would also like to note that the claim uses the transitional phrase "comprising." This transitional phrase is an open-ended phrase, meaning that more elements can be added to the claim. In this instance, the prior art can have more than one stem, as long as the prior art has a single stem. The use of the term "consisting" is a closed term, which limits the claim to just the limitations in the claim and nothing else, while comprising allows other limitations to be added along with the claimed limitations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (703) 308-2698. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew DeSanto
Art Unit 3763
December 13, 2004

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